

Appl. No. 10/064,483
Amdt. dated May 4, 2006
Reply to Office action of February 07, 2006

REMARKS/ARGUMENTS

The claims are not amended, and are listed above only for convenience to the Examiner.

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1. Rejection of claims 1-4, 6-9, and 11-12 under 35 U.S.C. 103(a) as being unpatentable over Frank, Jr. et al. (US 6,546,489), hereinafter "Frank," in view of Stevens (US 2002/0133702):

10 *Regarding claims 1, 6, and 12:*

The Examiner likens the claimed microcontroller to Frank's item 432 of Fig.2 and item 443 of Fig.3.

15 First, Fig.2 of Frank does not show an item 432. It is unclear whether the Examiner is referring to the host microcontroller 432 of Fig.3 or the PCI bridge 333 or host microprocessor 332 of Fig.2. Clarification is requested.

20 Second, since the microcontroller 443 is not part of the disk drive 424, it appears that the Examiner considers the disk drive 424 together with the computer 430 to be a "software delivery device" or "bootable device for delivering software" as claimed. The applicant argues that this is a mischaracterization. The cited combination raises the question: how could the combination deliver software? The disk drive/computer combinations
25 300, 400 are self-contained, and the host interfaces (connection ports) 326, 426 are necessarily occupied by virtue of the combination. It would not be apparent to one of ordinary skill in the art how to use the combination as a software delivery device. I.e., which element of the combination should be

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connected to a computer so as to deliver software to said computer?

According to MPEP 2141 II(B)&(D), the references must be considered as in their entirety and a reasonable expectation of success must exist. The
5 applicant argues that since Frank's disk drive 424 is separated from the microcontroller 443 by the very connection (host interface 426) that would allow the combination to deliver software, the Frank reference has not been considered in its entirety. One of ordinary skill in the art would not how to use the combination as a software delivery device.

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Further regarding claim 6:

Claim 6 recites a computer as being the target for software delivery. However, the Examiner seems to consider the computer 430 as both part of
15 the cited combination ("software delivery device") and as a target for software delivery. The applicant argues that this is inconsistent, and relates back to the point above. If the computer 430 is to be the target for software delivery by a "software delivery device," how can that same computer make up part of the software delivery device?

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Reconsideration of claims 1-4, 6-9, and 11-12 is respectfully requested. Claims 2-4, 7-9, and 11 are dependent and should be allowed if the corresponding independent claims are allowed.

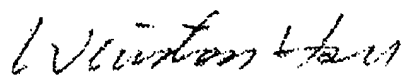
25 **2. Rejection of claims 5 and 10 under 35 U.S.C. 103(a) as being unpatentable over Frank and Stevens and further in view of Strom et al. (US 2004/0003274):**

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Claims 5 and 10 are dependent and should be allowed if the corresponding independent claims are found allowable.

Sincerely yours,

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Date: 05.04.2006

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